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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/486,866 | 03/02/2000 | EGON SCHULZ | P00.0408 | 6105 |

29177 7590 08/25/2004

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| EXAMINER |
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NGUYEN, STEVEN H D

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| ART UNIT | PAPER NUMBER |
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2665

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DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/486,866

Applicant(s)

SCHULZ ET AL.

Examiner

Steven HD Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10 and 20 is/are rejected.
- 7) ☐ Claim(s) 9 and 11-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/29/04 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8, 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagting (WO 97/15160) in view of Ward (USP 5974320).

Regarding claims 1, 4, 6-8 and 20, Hagting discloses (Figs 1-7 and Pages 1-20) the DECT systems (Fig 4) comprising a plurality of base stations (Fig 4, Ref 11 and 12) wherein at least one second base station is asynchronous to the first base stations which are synchronous with the mobiles parts; the at least one second base stations being in a proximity of the first base stations; first and second base stations and first base stations being connective by the wireless transmission messages (Fig 4, Ref 14-16 and Page 13, lines 23-27, the first base stations of first system are not synchronous with the second base stations of the second system so they are

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partially asynchronous with each other; during the handover the mobile receives the messages from both systems, See Fig 4b and Page 5, lines 13 to page 7, lines 25). However, Hagting fails to disclose the first base stations transmit the first messages that indicate the first base stations are surrounded by at least one of the second base stations. In the same field of endeavor, Ward discloses the first base stations regularly or automatically transmit the first messages having first information indicating that the first base stations are surrounded by at least one of the second base stations network side (Col 3, lines 5-24 and col. 8, lines 28-50).

Since, Hagting suggests that a list of the synchronous and asynchronous base stations can be provided. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a step of broadcasting a message which indicates the first base stations being surrounded by at least one of the second base stations as disclosed by Ward's system and method into Hagting's method and system. The motivation would have been to provide a mobile to select a best cell to perform a handover.

Regarding claims 2-3, Hagting discloses a synchronism between the first base stations and the first mobile parts exists in idle or active locked mode the first mobile parts (Page 4, lines 8-14; Page 6, lines 20-25 and Page 15, lines 5-12)

Regarding claim 5, Hagting implicitly discloses the first base stations are respectively asynchronous relative to the second base station in view of at least one of bit, time slot and time frame synchronism.

Regarding claim 10, Hagting implicitly discloses the first mobile parts are respectively asynchronous relative to the first base station in view of at least one of bit, time slot and time frame synchronism.

Allowable Subject Matter

4. Claims 9 and 11-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments filed 4/29/04 have been fully considered but they are not persuasive.

In response to applicant's argument in page 6 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., first messages ... **first synchronous base stations**, ... **second asynchronous base stations**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. In response to page 6, the applicant states that Ward does not disclose a first base station transmits a message includes a first information for indicating the first base station being surround by the at least one of the second base stations. In reply, Ward discloses the first base station "the base station is serving the mobile" transmits a first message "read on neighborhood list" includes an indication "reads on one channel that associated with surrounding cells" that the base station is surrounded by at least one of the second base stations (See col. 6, lines 2-36 and col. 8, lines 38-49).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hagting discloses a method and system for handoff between the first and second base station when roaming between synchronous and asynchronous and Ward discloses a method and system for receiving the first messages having first information indicating that the first base stations are surrounded by at least one of the second base stations network side. Since, Harting suggest a list for using to perform a handover between the base stations. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a step of broadcasting a message which indicates the first base stations being surrounded by at least one of the second base stations as disclosed by Ward's system and method into Hagting's method and system. The motivation would have been to provide a mobile to select a best cell to perform a handover.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (571) 272-3159. The examiner can normally be reached on 8-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (571) 272-3155. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven HD Nguyen
Primary Examiner
Art Unit 2665
8/22/04